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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/871,480	05/31/2001	Alfred Steidl	3986-4	1532
29540	7590	04/26/2004	EXAMINER	
PITNEY HARDIN LLP			NORDMEYER, PATRICIA L	
685 THIRD AVENUE			ART UNIT	
NEW YORK, NY 10017-4024			PAPER NUMBER	

1772

DATE MAILED: 04/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/871,480	<b>Applicant(s)</b> STEINL, ALFRED	
	<b>Examiner</b> Patricia L. Nordmeyer	<b>Art Unit</b> 1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 05 March 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☒ Claim(s) 1 and 3-25 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Repeated Rejections*

1. The 35 U.S.C. 103 rejection of claims 1, 3 – 21, 24 and 25 over Davis et al. (USPN 5,302,466) are repeated for the reasons of record in the paper dated November 5, 2003.

Davis et al. disclose a strip (Column 4, line 49 and Figure 8, #82) with a plurality of opposing tabs or legs on opposites sides of the longitudinal axis (Column 4, lines 55 – 58 and Figure 8, #88) having a thickness of 0.51 mm (Column 4, lines 49 – 50) made from metal (Column 4, line 63). Each leg is connected by a connection element (Figure 8, #94) and contains a hole, which extends transversely to the longitudinal length of the strip, the hole comes to a point on both ends and mirrors the hole formed across from it (Figure 8, #114). The holes contain two sections, the first section having a triangular shape with an angle between 10° to 80° that expands from the longitudinal axis towards the second section (Figure 8, #114). In between the openings of each leg and overlapping the longitudinal axis, a second connection element having the same shape (Figure 8, #110) is formed that allows the strip to extend in the longitudinal direction (Figure 8, #82) and has an angle in the range of 10° to 80° with respect to the longitudinal axis (Figure 8, #109). A cut-out is formed in between the legs of the strip that extends from the edge to the first connection element forming an angle within the range of 2° to 30° (Figure 8, #89). Figure 8 shows the first element extends across the longitudinal axis while the cut-outs are arranged symmetrically across from each other with parallel sides along the longitudinal axis of the strip. Also seen in Figure 8, the points of the holes are offset from each

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other relative to the longitudinal axis. It also shows that the gap between the parallel sides is  $1/10$  to  $1/20$  of the length of the gap and has a V-shape (Column 5, lines 7 – 9), which widens as it approaches the edge of the strip. The tabs or legs are U-shaped (Column 4, line 56), having a straight edge (Figure 8, #88) with rounded corners. As may be seen in Figure 1, the legs of the strip are bent out of the plane of the longitudinal axis (Figure 1, #20) when used in a weather strip having an extruded rubber body (Column 3, lines 15 – 18). However, Davis et al. fails to disclose the second connecting element being inclined relative to said longitudinal axis, each cut-out rounded in the area of the first connecting element and forms an arc of a circle having a radius  $R1$ , the radius  $R1$  being in the range of 0.2 to 1.5 mm, the second section includes sides that are perpendicular to the longitudinal axis and further comprising a third section that widens towards the edge of the strip and adjoins the second strip, the third section is V-shaped and is symmetrical about a perpendicular axis to the longitudinal axis and encloses an angle  $W2$  which in the range of  $2^\circ$  to  $30^\circ$  from said perpendicular axis and the opening comprises a fourth section and said section is spaced apart from the edge of the strip and rounded with a radius  $R2$  that is in the range of 0.5 to 5 mm.

Davis et al. disclose the claimed invention except for a third section that widens towards the edge of the strip and adjoins the second strip, the third section is V-shaped and is symmetrical about a perpendicular axis to the longitudinal axis and a fourth section that is rounded and spaced apart from the edge of the strip. It would have been obvious to one of ordinary skill in the art at the time the invention was made to reverse the direction of the holes in Davis et al so that the rounded edge of the opening was close to the edge of the strip, since it has

been held that a mere reversal of the essential working parts of a device involves only routine skill in the art. *In re Einstein*, 8 USPQ 416. From Figure 8, the angle of the third section, once it was reversed, would be between 2° to 30°.

It is well settled that a particular shape of a prior invention carries no patentable weight unless the applicant can demonstrate that the new shape provides significant unforeseen improvements to the invention. See *In re Seid*, 161 F.2d 229, 73 USPQ 431 (CCPA 1947) Also, see *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966). In the instant case, the application does not indicate any new, significant attributes of the invention due to its shape, which would have been unforeseen to one of ordinary skill in the art. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to change the shape of the cutout to have a semicircular shape and to change the shape of the second connecting element to have an incline relative to the longitudinal axis depending on the desired end results and absence of unexpected results. One skilled in the art would have been motivated to do so in order to form a strip that has a uniform shape down the longitudinal axis.

One of ordinary skill in the art would have recognized that the openings would have a radius of 0.5 to 5mm in the fourth section and 0.2 to 1.5 mm in the rounded area of the cutout since Davis et al. teaches using the support in weather stripping, which would require smaller openings to obtain adhesion between the support strip and the rubber. Therefore, one of ordinary skill in the art would readily determine the optimum radius for both the openings and the cutouts depending on the end desired results absence of unexpected results.

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2. The 35 U.S.C. 103 rejection of claims 1, 19, 22 and 23 over Hein (USPN 4,348,443) are repeated for the reasons of record in the paper dated November 5, 2003.

Hein discloses a strip (Column 3, line 33 and Figure 1, #2) with a plurality of opposing tabs or legs (Column 3, lines 48 – 51 and Figure 1, #6) made from metal (Column 3, line 33). Each leg is connected by a connection element (Figure 1, #4) and contains a hole, which extends transversely to the longitudinal length of the strip, the hole comes to a point on both ends and mirrors the hole formed across from it (Figure 1, #12). Also seen in Figure 1, the holes are offset from each other relative to the longitudinal axis. In between the openings of each leg and overlapping the longitudinal axis, a second connection element having the same shape (Figure 1, #4) is formed that allows the strip to extend in the longitudinal direction (Column 3, lines 49 - 50). The holes, openings, in the metal strip are formed with a punching die (Column 3, lines 42 – 44). However, Hein fails to disclose the second connecting element being incline relative to the longitudinal axis.

It is well settled that a particular shape of a prior invention carries no patentable weight unless the applicant can demonstrate that the new shape provides significant unforeseen improvements to the invention. See *In re Seid*, 161 F.2d 229, 73 USPQ 431 (CCPA 1947). Also, see *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966). In the instant case, the application does not indicate any new, significant attributes of the invention due to its shape, which would have been unforeseen to one of ordinary skill in the art. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to change the shape of

the second connecting element to have an incline relative to the longitudinal axis depending on the desired end results and absence of unexpected results. One skilled in the art would have been motivated to do so in order to form a strip that has a uniform shape down the longitudinal axis.

***Response to Arguments***

3. Applicant's arguments filed March 5, 2004 regarding the 35 U.S.C. 103 rejections of claims 1 and 3 – 25 have been fully considered but they are not persuasive.

In response to Applicant's argument that both Davis et al. and Hein fail to disclose the openings extending to the longitudinal axis and the second connecting element in between the openings to be at an incline, it is well settled that a particular shape of a prior invention carries no patentable weight unless the applicant can demonstrate that the new shape provides significant unforeseen improvements to the invention. The application does not indicate any new, significant attributes of the invention due to the shape of the openings, which would have been unforeseen to one of ordinary skill in the art. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to change the shape of the second connecting element to have an incline relative to the longitudinal axis depending on the desired end results and absence of unexpected results. One skilled in the art would have been motivated to do so in order to form a strip that has a uniform shape down the longitudinal axis. Therefore, the claims have been rejected with the shape being treated as an ornamental design of the strip of material.

***Conclusion***

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Nordmeyer whose telephone number is (571) 272-1496. The examiner can normally be reached on Mon.-Thurs. from 7:00-4:30 & alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Y. Pyon can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Patricia L. Nordmeyer  
Examiner  
Art Unit 1772

*pln*  
pln

*[Signature]*  
HAROLD PYON  
SUPERVISORY PATENT EXAMINER  
1772

4/22/04